

REMARKS

The Examiner's attention is drawn to a typographical misnumbering that occurred when previously numbering the claims. The last four claims, presented in the list above have been renumbered 99-102 (from previous numbers 100-103). These amended claims will be referred to using the numbers 99-102.

Claims 74-102 are currently pending in the application. Claim 96 is amended.

§102(e) Rejection

1. The Claims Are Not Anticipated by Cui Because Cui Does Not Disclose a Valve That Is Inoperable After a First Actuation

The Examiner rejected claims 74, 75, 79, 85-92 and 94-102 under 35 USC §102(e) as allegedly being anticipated by Cui (US 6,576,193).

In order to anticipate a claim, each and every element and limitation of the claimed invention must be found in a single prior art reference, arranged as in the claim. *Brown v. 3M*, 265 F.3d 1349, 60 USPQ2d 1375 (Fed. Cir. 2001). The reference must teach every aspect of the claimed invention either explicitly or impliedly. MPEP 2131.

The present claims recite that the device comprises a valve that is "inoperable after a first actuation." Cui discloses no such valve, and therefore cannot anticipate the claims.

The Examiner stated that the recitation "the valve being inoperable after a first actuation" is merely an intended use of the valve and that a recitation of intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art (Office Action dated 8/31/05, p. 3, line 14). The Examiner appears to be referring to case law that addresses a mere recitation of use in a preamble of a claim, which is not considered a limiting element if it is not necessary to breath life and meaning into the claim. *Loctite Corp. v. Ultraseal Ltd.*, 781 F.2d 861; 228 USPQ 90 (Fed. Cir. 1985).

In the present application, the limitation at issue is in the body of the claim, not the preamble, and is not a mere recitation of use but a stated characteristic of the valve. The limitation of inoperability after a first actuation represents a specific characteristic of the claimed

invention and a genuine limitation of the claim that must be evaluated with every other limitation – the valve must be inoperable after a first actuation. Case law clearly establishes that each element contained in a patent claim is deemed material to defining the scope of the patent invention. *Warner-Jenkinson Co., Inc. v. Hilton Davis Chemical Co.*, 520 U.S. 17; 41 USPQ2d 1865 (1997), on remand, 114 F.3d 1161; 43 USPQ2d 1152 (Fed. Cir. 1997) (Order Per Curiam). Even functional language in a claim cannot be disregarded. *Pac-Tec, Inc. v. Amerace Corp.* 903 F.2d 796; 14 USPQ2d 1871 (Fed. Cir. 1990), *cert denied sub nom. Perry v. Amerace Corp.*, 502 U.S. 808 (1991). Thus, no legal basis exists for disregarding the recited claim element. Furthermore, this limitation must be evaluated in view of the specification, which contains relevant disclosure at p. 21, line 10 et seq.

Since Cui does not disclose every limitation of the claim, it cannot anticipate the claim. Reconsideration and withdrawal of the rejection is respectfully requested.

§103(a) Rejections

The Examiner variously rejected claims 76 -78, 80 - 84 and 93 under 35 USC §103(a) as allegedly being unpatentable over Cui (US 6,576,193) in view of various references [Nelson (US 5,115,934), Alley (US 2002/00446614), Mitsumaki (US 4,680,270), Pampinella (US 2002/0023482), Carter (US 4,909,933) and Ehrenkranz (US 4,769,215)].

In order to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) and MPEP 2142.

As discussed above Cui fails to disclose a valve that is inoperable after a first actuation. Moreover, none of the references cited by the Examiner disclose this limitation of the cited claims, nor suggest the use of the valve recited in the claims. Therefore, the cited combinations of art do not disclose all of the claim limitations.

Accordingly, for these reasons and those already described above, the presently claimed invention is not obvious over any combination of the cited references.

Double Patenting

A. The Applicant will Submit a Terminal Disclaimer Under 37 CFR §1.321, if the Claims Are Otherwise Allowable in Their Present Form

The Examiner has rejected claims 74-102 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-62 of copending Application No. 10/211,199.

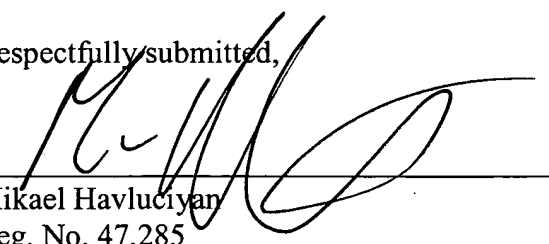
The Applicant will submit a terminal disclaimer in the present case if the claims are otherwise allowable in their present form, and if the claims of the cited co-pending application are allowed prior to the present claims.

Conclusion

Applicant respectfully submits that the pending claims are now in condition for allowance and respectfully requests the same. If the Examiner has any questions regarding the foregoing, he is cordially invited to contact the undersigned so that any such matters may be promptly resolved. Please apply any charges or credits to deposit account 06-1050.

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Respectfully submitted,


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